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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,104	04/24/2001	Fritz Magerl	LUD-PT002-PA1083US	6204

3624 7590 03/22/2007  
VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103

EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/701,104

Applicant(s)

MAGERL ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-8,10,12,13,15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8,10,12,13,15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **RESPONSE TO AMENDMENT**

### ***Request for Continued Examination***

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on December 28, 2006 is acceptable and a RCE has been established. An action on the RCE follows.
2. Amendments to the claims, filed on December 28, 2006, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §112 rejections of claims 12, 15 and 19, made of record in office action mailed August 28, 2006, paragraph #4 have been withdrawn due to Applicant's amendment in the response filed December 28, 2006.

### ***REJECTIONS***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

5. Claims 3, 5-8, 10, 12, 13, 15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “surgically implantable” in claims 12, 15 and 19 is unclear which renders the claims vague and indefinite. The “surgically implantable” begs the question into what? It is clear that “surgically implantable” is either an intended use or functional limitation but the phrase does not claim the actual function or use.

Claim 4 recites “further comprising PAEK (poly-aryl-ether ketone)” which is unclear. Claim 4 is dependent on claim 19 and it unclear whether the PAEK (poly-aryl-ether ketone) is the polymer or ceramic material.

Claim 6 recites “the fibers are enveloped by a matrix material” which is unclear. Claim 6 is dependent on claim 19 and it unclear whether the matrix material is the polymer or ceramic material.

#### ***Claim Rejections - 35 USC § 102***

6. Claims 3, 5-8, 10, 12, 13, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Crane (U.S. Patent No. 4,255,478).

Regarding Applicant’s claims 12, 15 and 19, Crane discloses a component (*title*) made from a composite of polymer or ceramic material (*thermosetting reins, col. 2, lines 30-31*) comprising, reinforcing fibers (*carbon and boron/tungsten fibers, col. 2, line 24 and col. 4, line 15*), wherein at least some of the reinforcing fibers are x-ray absorbing reinforcing fibers distributed throughout the composite (*figure 2*), wherein an orientation of the x-ray absorbing reinforcing fibers is tailored to a shape and application of the component in a defined manner to provide x-ray visibility control for the component (*figure 2 and col. 4, lines 15-21*), a

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concentration of the x-ray absorbing fibers is varied in different areas of the component (*figure 2*).

The preamble “surgically implantable” has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

Regarding Applicant’s claim 3, figure 1 in Crane is deemed to show the composite is prefabricated as a profile rod material, since the figure shows a rectangular shape. Crane also discloses that the composite further comprises carbon fibers (*col. 2, line 24*).

Regarding Applicant’s claim 5, figure 1 in Crane shows that the fibers are continuous fibers.

Regarding Applicant’s claim 6, Crane discloses that the fibers are enveloped by a matrix material (*col. 2, lines 62-66*).

Regarding Applicant’s claims 7 and 8, Crane discloses that the fibers comprise nonmagnetic material, such as, tungsten (*col. 4, lines 15-16*).

Regarding Applicant’s claim 10, the fibers in Crane are deemed to be oriented differently depending on the longitudinally or transverse oriented alignment of the component.

Regarding Applicant’s claim 13, Crane’s component is deemed to be a connecting element.

The limitation “the stiffness of the connecting element *can be* varied by varying the orientation of fibers from a force application point toward a free end of the component ” is a

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functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure. MPEP 2145 (II).

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

7. Applicant's arguments in the response filed December 28, 2006 regarding the previous rejections of record have been considered but are moot due to the new grounds of rejection.

However, the examiner would like to comment on the phrase "surgically implantable." It is believed that Applicant is trying to claim that the component is implantable into the human body or living tissue, which would give weight to the intended use or functional limitation in the claim. That said the examiner is unable to find support in the specification for such an amendment.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

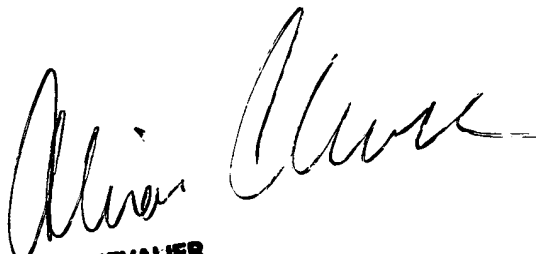
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

3/18/07

A handwritten signature in black ink, appearing to be 'AC' followed by a horizontal line.A handwritten signature in black ink, appearing to be 'Alicia Chevalier'.

**ALICIA CHEVALIER  
PRIMARY EXAMINER**